

### **REMARKS**

As a result of the above amendments, claims 1-94 remain pending. Claims 1, 5-49 and 54-94 have been herein amended. Applicants respectfully submit that no new matter has been added by this Reply. Accordingly, Claims 1-94 are at issue.

The present invention is drawn to a system and method for distributing an electronic article content file. Referring to exemplary Claim 1, as amended, the electronic article content file is distributed utilizing micro-pricing. A plurality of electronic article content files is received from a plurality of users which is then stored and retrieved from a memory. Once a user requests the purchase of the electronic article content file, the system debits funds from an electronic funding account associated with the user and provides for transmitting the electronic article content file to the user. One novel feature of the present invention is providing for calculating a rating for the electronic article content file.

As will be demonstrated herein, the prior art cited by the Examiner in the January 3, 2006 Office Action does not disclose, anticipate or suggest each and every element of the claims of the present application.

### **Remarks Concerning Rejections Under 35 U.S.C. § 112**

On page 2 of the January 3, 2006 Office Action, the Examiner rejected Claims 1-94 under § 112, ¶ 1, for failing to comply with the enablement requirement. Specifically, the Examiner found the phrase “creative content file(s)” to lack antecedent basis in the application as originally filed. That phrase is in Claims 1, 5-10, 12-24, 28-42, 44-49, 54-73, 79-88, and 90-94, which have been herein amended so that the phrase “creative” is no longer a part of the limitation. The limitation is now “electronic article content file(s)”. In light of that amendment, Applicants respectfully traverse that rejection. Applicants respectfully submit that the phrase “electronic article content file(s)” is fully and adequately described in the specification as electronic information such as stories, recipes, reviews, poems, news, hobby-related information, instructions, and other information to the system (page 3, lines 30-31 and page 4, lines 1-2 of the application as originally filed). Claims 1, 5-10, 12-24, 28-42, 44-49, 54-73, 79-88, and 90-94, as amended, are therefore compliant with § 112, ¶ 1. The remaining claims of the present

application are dependent on either Claim 1, 24, 47 or 71, as amended, and therefore satisfy the requirements of § 112 for the same reasons. Applicants thus respectfully request that the rejection be withdrawn.

On pages 2-3 of the January 3, 2006 Office Action, the Examiner rejected Claims 15, 22-23, 38, 45-46, 48-49, 64, 72-73, and 88 under § 112, ¶ 2, as lacking antecedent basis for a limitation in the claim. Specifically, the Examiner found the phrases “micro-price range” and “micro-pricing” to be non-compliant with § 112. Applicants respectfully traverse that rejection. “[M]icro-price range” and “micro-pricing” is defined to be small monetary increments, for example, \$0.05, as stated in page 7, line 23 of the application as originally filed. Applicants therefore respectfully submit that the phrases “micro-price range” and “micro-pricing” are fully and adequately described in the application as originally filed. Claims 15, 22-23, 38, 45-46, 48-49, 64, 72-73, and 88, are therefore compliant with § 112, ¶ 2. Applicants thus respectfully request that the rejection be withdrawn.

On page 3 of the January 3, 2006 Office Action, the Examiner rejected Claims 22-23, 45-46, 48-49 and 72-73 under § 112, ¶ 2, as being incomplete for “omitting essential steps, such omission amounting to a gap between the steps.” With respect to Claim 22, the Examiner objected to “calculating a creative content file rating.” Claim 22 has been herein amended to clarify that calculating the rating is based on the number of times the one of the electronic article content files has been purchased. With respect to Claim 23, the Examiner objected to “calculating a combined rating.” Claim 23 has been herein amended to clarify that calculating the rating is based on at least one user rating received from at least one of the plurality of users. Furthermore, calculating the rating is fully and adequately described in the application as originally filed, beginning on page 9 of the application. Accordingly, Applicants submit that Claims 22-23, 45-46, 48-49 and 72-73 satisfy the requirement of § 112, and respectfully request that the § 112 rejection of Claims be withdrawn.

#### **Remarks Concerning Rejections Under 35 U.S.C. § 102**

On pages 3-10 of the January 3, 2006 Office Action, the Examiner rejected Claims 1-17, 19, 21, 24-40, 42, 44, 47, 50-66, 68-69, 71, 74-9, 92 and 94 as being anticipated under 35 U.S.C.

§ 102(b) by U.S. Patent No. 5,629,980 to Stefik et al. ("Stefik"). In light of the amendments and remarks made herein, Applicants respectfully traverse that rejection and submit that the claims are in condition for allowance.

Stefik is directed to a system for controlling the distribution and use of digital works. Stefik provides for access to digital works for the purposes of transporting between repositories using a digital work transport protocol. Stefik does not, however, disclose "providing for calculating an electronic article content file rating for one of the plurality of electronic article content files," which is an element of all of the independent claims of the present invention (Claims 1, 24, 47 and 71).

In the present invention, calculating an electronic article content file rating is based on the number of times the electronic article content files have been purchased. Alternatively, the rating can be based on a user rating received from at least one of the plurality of users. Stefik does not disclose calculating a rating for an electronic article content file that operates in such a way.

In fact, Stefik includes no disclosure of calculating an electronic article content file rating at all. On page 7 of the January 3, 2006 Office Action, the Examiner opined that Stefik discloses a rating in column 10, lines 59-65. Yet, that portion of Stefik makes no disclosure of a rating or any element that operates similarly. Indeed, no other portion of the Stefik patent makes that disclosure either.

Stefik fails to disclose the rating of the present invention, which is an element of all of the independent Claims 1, 24, 47 and 71 of the present application. Applicants therefore respectfully submit that those claims are patentable over Stefik, and respectfully request that the § 102 rejection be withdrawn. Claims 2-27, 29 and 21 are dependent on Claim 1, Claims 25-40, 42 and 44 are dependent on Claim 24, Claims 50-66 and 68-69 are dependent on Claim 47, and Claims 74-90, 92 and 94 are dependent on Claim 71. Those dependent claims include all of the limitations of the independent claims and are thus patentable over Stefik for the same reasons. Applicants therefore respectfully request that the § 102(b) rejection of those claims be withdrawn as well.

Claims 1 and 24 of the present application are also patentable over Stefik for a second reason, which is that Stefik does not disclose "a fifth code segment for transmitting the creative

content file to the one of the plurality of users.” The Examiner cited column 23, lines 1-2 of Stefik as disclosing the transmission of the electronic article content files. Yet nowhere in Stefik, including the cited portion, is such a transmission of electronic article content files disclosed. In fact, Examiner acknowledges on Page 11 of the January 3, 2006 Office Action that Stefik does not disclose the transmission of the electronic article content files, which is a limitation required by Claims 1 and 24 of the present application. Stefik does not disclose that feature, and therefore Applicants respectfully submit that Claims 1 and 24 and their dependent claims (2-17, 19, 21, 23-40, 42 and 44) are patentable over Stefik for that additional reason.

Because Stefik does not disclose or suggest the rating element or the transmission of the electronic article content file element of the independent claims of the present application, Applicants respectfully submit that all of the claims are patentable over Stefik, and request that the § 102(b) rejection be withdrawn.

### **Remarks Concerning Rejections Under 35 U.S.C. § 103**

On pages 11-13 of the January 3, 2006 Office Action, the Examiner rejected Claims 18, 20, 22-23, 41, 43, 45-46, 48-49, 67, 70, 72-73, 91 and 93 under 35 U.S.C § 103(a) as being patentable over U.S. Patent No. 5,629,980 to Stefik et al. (“Stefik”) in view of European Patent No. 1 255 213 A2 to Chatani et al. (“Chatani”). Applicants respectfully traverse that rejection.

Stefik is directed to a system for controlling the distribution and use of digital works. Stefik provides for access to digital works for the purposes of transporting between repositories using a digital work transport protocol. Stefik does not, however, disclose calculating an electronic article content file rating for one of the plurality of electronic article content files.

Chatani fails to cure the deficiencies of Stefik. Chatani is directed to a method and system for providing evaluation of text-based products. However, like Stefik, Chatani does not disclose in any way calculating an electronic article content file rating for one of the plurality of electronic article content files. On page 13 of the January 3, 2006 Office Action, the Examiner opined that Chatani discloses the ranking element in column 6, lines 21-34. Yet, that portion of

Chatani makes no disclosure of the ranking element or any element that operates similarly. No other portion of the Chatani patent makes that disclosure either.

Neither Stefik nor Chatani discloses calculating an electronic article content file rating for one of the plurality of electronic article content files. Claims 1, 24, 47 and 71 all include that limitation, and are therefore patentable over the combination of Stefik and Chatani. Claims 18, 20 and 22-23 are dependent on Claim 1, Claims 41, 43 and 45-46 are dependent on Claim 24, Claims 48-49, 67 and 70 are dependent on Claim 47, Claims 72-73, 91 and 93 are dependent on Claim 71, and are therefore patentable for the same reasons. Applicants thus respectfully request that the rejection based on those references be withdrawn.

Applicants further respectfully submit that the combination of Stefik and Chatani is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613; 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where a teaching, suggestion or motivation to do so is found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071; 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347; 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and a reasonable expectation of success of that combination must both be found in the prior art, not in the applicant's disclosure, *In re Vaeck*, 947 F.2d 488; 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness, MPEP § 2142. In the present case, the Examiner has failed to meet that burden. Instead, the Examiner has simply concluded one skilled in the art would make the suggested modification. That is insufficient.

The Examiner has opined that there is an incentive to combine Stefik and Chatani because "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Stefik teaching Chatani teaching to display the creative content file on a Web site, electronically mailing the creative content file, and/or providing the creative content file for download." (p. 12, January 3, 2006 Office Action). However, that incentive is

not found in any of the cited references. It is instead simply a hindsight determination, which is an improper foundation upon which to combine references.

Hindsight combination of references, using the present invention as a roadmap, is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed invention obvious, *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Applicants therefore respectfully submit that the combination of the Stefik and Chatani references is improper. For that reason, in addition to the fact that Stefik and Chatani do not disclose the elements of the claims of the present invention, Applicants respectfully request that the rejection based on those references be withdrawn.

Application No. 10/612,653  
Attorney Docket No. 3361 P 002  
Reply to Office Action of January 3, 2006

### CONCLUSION

In light of the remarks made herein, Applicants respectfully submit that Claims 1-94 are in condition for allowance. Applicants respectfully request that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

Respectfully submitted,

Dated: April 3, 2006

By: Brad Rademaker  
Bradley F. Rademaker, Reg. No. 35,544  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, Illinois 60606-6630  
312.554.3300

---

**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 3, 2006.

Lynn A. Liebergen  
Lynn A. Liebergen/242455